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In re Application of GOTO et al
U.S. Application No.: 10/541,518
PCT Application No.: PCT/JP2003/015731
Int. Filing Date: 09 December 2003
Priority Date Claimed: 15 January 2003
Attorney Docket No.: 81864.0064
For: PATTERN FORMATION DEVICE,
PATTERN FORMATION METHOD AND
PATTERN FORMATION SYSTEM

DECISION

This is in response to applicant's "Petition Under 37 C.F.R. § 1.47(a) for Filing on Behalf of a Joint Inventor Who Does Not Sign" filed 22 December 2006.

BACKGROUND

On 09 December 2003, applicant filed international application PCT/JP2003/015731, which claimed priority of an earlier Japan application filed 15 January 2003. A copy of the international application was communicated to the USPTO from the International Bureau on 29 July 2004. The thirty-month period for paying the basic national fee in the United States expired on 15 July 2005.

On 07 July 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 09 February 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 13 July 2006, applicant filed a petition under 37 CFR 1.47(a) along with an executed declaration.

On 24 August 2006, the DO/EO/US mailed a Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903).

On 18 October 2006, this Office mailed a decision dismissing the 13 July 2006 petition and vacating the 24 August 2006 Notice of Acceptance.

On 22 December 2006, applicant filed the present renewed petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

Applicant has previously satisfied items (3) and (4) above.

With regard to item (1) above, the declaration filed 13 July 2006 satisfies 37 CFR 1.69(b) in view of the statement by Miyuki Horikawa that the translation contained in the declaration is accurate.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

* * *

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that joint inventor Hideki Kishi refuses to sign the application papers. Although the petition sufficiently establishes that a bona fide attempt was made to present a copy of the application papers to Kishi for signature (see affidavit of Miyuki Horikawa, ¶2), it cannot be determined whether Kishi actually received the correspondence that was sent to him. Although Horikawa's affidavit states that the mailings were not returned to sender, there is no evidence that Kishi still lives at the last known address of record or signed for the correspondence.

The petition states that Kishi cannot otherwise be located. The petition adequately demonstrates that a diligent effort was made to reach Kishi. Specifically, applicant tried to contact Kishi via postal mail, through Kishi's former employer, by searching telephone directories, and by searching a patent database. Thus, it can be concluded with reasonable certainty that Kishi cannot be found.

CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.47(a) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 09 December 2003, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 13 July 2006.

As set forth in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at the last known address of record and will be published in the *Official Gazette*.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

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